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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,279	06/04/2009	Timothy Olof Eagle	78104111-N18906	8780

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Intellectual Property Dept.
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EXAMINER

THOMAS, ALEXANDER S

ART UNIT	PAPER NUMBER
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1783

NOTIFICATION DATE	DELIVERY MODE
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07/13/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket-ip@dewittross.com

Office Action Summary	Application No.	Applicant(s)	
	10/597,279	EAGLE, TIMOTHY OLOF	
	Examiner	Art Unit	
	ALEXANDER THOMAS	1783	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2009 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/19/06</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

1. The drawings are objected to because numeral 12 in Figure one does not designate a part of the Figure. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

Art Unit: 1783

regards as the invention. Since “double glazed glass” may be of any width, the scope of the claim is indefinite.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by Trussell 2,772,596. Trussell discloses a shim including first and second wedge elements arranged coplanar to one another and a connecting element as a thick end of the shim wherein the wedge elements are detachable from the connecting element; see Figures 3-5 and column 3, lines 49-54. The phrase “for building applications” is a statement of intended use and does not add any patentably distinguishing features to the claimed product.

5. Claims 1-4 and 7-11 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0719953. EP 0719953 discloses a shim including first and second wedge elements arranged coplanar to one another, a connecting element as a thick end of the shim and retaining members 11, 12, 15, 16 between said wedge elements; see Figures 1-2.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

Art Unit: 1783

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-18 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trussell 2,772,596 in view of Rath sack 6,159,575. Trussell discloses a shim including first and second wedge elements arranged coplanar to one another and a connecting element as a thick end of the shim wherein the wedge elements are detachable from the connecting element; see Figures 3-5 and column 3, lines 49-54. However, he does not disclose retaining members on the wedge elements. Rath sack discloses placing elastic retaining tabs between the wedge elements of a shim for holding the shim in place during use; see column 4, lines 4-9. It would have been obvious to one of ordinary skill in the art to place elastic retaining tabs between the wedge elements of shim in Trussell in view of the teachings in Rath sack to provide a means of holding the shim in place. Concerning claim 6, it would have been obvious to one of ordinary skill in the art to provide any particular spacing of the retaining tabs on the product of the combined prior art to provide a desired holding power for a particular end use since a shifting of the location of parts is within the level of ordinary skill in the art. Concerning claim 12, it would have been obvious to one of ordinary skill in the art to vary the width of the wedge elements in the combined prior art product to within the claimed range to satisfy the size needs for a particular end use since a change in size is generally recognized as being within the level of ordinary skill in the art. Concerning claims 16 and 17, Rath sack discloses the use of recesses on the wedges in his shim to provide stability; see column 3, lines 38-40. It would have been obvious to one of ordinary skill in the art to place recesses on the shim of the combined prior art in view of

Art Unit: 1783

Rathsack to provide stability to the shim. Concerning claim 18, it would have been obvious to one of ordinary skill in the art to use any well-known material, such as metal, plastic, etc., to form the shim of the combined prior art since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

8. Claims 2, 5, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0719953 in view of Rathsack 6,159,575. EP 0719953 discloses the invention substantially as claimed; see the above rejection under 35 USC 102. However, it does not disclose the use of resiliently deformable retaining members. Rathsack discloses the use of resiliently deformable retaining members on the wedges of his shim to prevent the shim from falling out when in use; see column 4, lines 4-9. It would have been obvious to one of ordinary skill in the art to form the retaining members in the product of the primary reference from resilient material in view of the teachings in the secondary reference. Concerning claims 16 and 17, Rathsack discloses the use of recesses on the wedges in his shim to provide stability; see column 3, lines 38-40. It would have been obvious to one of ordinary skill in the art to place recesses on the shim of the combined prior art in view of Rathsack to provide stability to the shim.

9. Claims 6, 12 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0719953. EP 0719953 discloses the invention substantially as claimed; see the above rejection under 35 USC 102. However, it does not disclose the claimed spacing of retaining elements, width of the wedges or materials used to make the shim.

Art Unit: 1783

It would have been obvious to one of ordinary skill in the art to use any particular spacing of the retaining tabs on the product of EP 0719953 to provide a desired holding power for a particular end use since a shifting of the location of parts is within the level of ordinary skill in the art. Concerning claim 12, it would have been obvious to one of ordinary skill in the art to vary the width of the wedge elements in the combined prior art product to within the claimed range to satisfy the size needs for a particular end use since a change in size is generally recognized as being within the level of ordinary skill in the art. Concerning claim 18, it would have been obvious to one of ordinary skill in the art to use any well-known material, such as metal, plastic, etc., to form the shim of the combined prior art since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

10. Claims 13, 14, 19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0719953 in view of either Trussell 2,772,596 or Relly 5,624,724. EP 0719953 discloses the invention substantially as claimed; see the above rejection under 35 USC 102. However, it does not disclose V-shaped break lines on the shim. The secondary references each disclose the use of break lines on shims to adjust the size of the shims; see column 3, lines 49-55 of Trussell and column 3, lines 21-25 of Relly. It would have been obvious to one of ordinary skill in the art to place V-shaped break lines on the product of the primary reference in view of the teachings in the secondary references in order to have the ability to adjust the size of the shim.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALEXANDER THOMAS whose telephone number is (571)272-1502. The examiner can normally be reached on 6:30-4:00 M-THUR.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alexander Thomas/
Primary Examiner
Art Unit 1783